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Daniel Doll-Steinberg

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SUITE 1300

DAYTON, OH 45402-2023

EXAMINER

SHERR, CRISTINA O

ART UNIT

PAPER NUMBER

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/868,435	Applicant(s) DOLL-STEINBERG, DANIEL	
	Examiner CRISTINA SHERR	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 77-108 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 77-108 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to Applicant's Amendment filed December 23, 2009. Claims 26-31 and 50-76 have been canceled. Claims 77-108 have been newly added. Accordingly, claims 77-108 are currently pending in this case.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 23, 2009 has been entered.

Election/Restrictions

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 77-84, drawn to a point of sale apparatus for interacting with a remote license center, classified in class 705, subclass 57.
- II. Claims 85-108, drawn to a method and apparatus for distributing digital data, classified in class 709, subclass 219.

4. Newly submitted claim 85-108 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

5. Inventions Group I and Group II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP §

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808.01). In the instant case the different inventions the inventions are separate and distinct and do not require the specifics of each other to function.

6. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 85-108 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

7. Applicant's arguments with respect to claims 77-108 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 77-84 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112, paragraph 2, as such a claim is not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved. *IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990). A single claim which purports to be both a product or machine and a process is

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ambiguous and is properly rejected under 35 USC 112, second paragraph, for failing to particularly point out and distinctly claim the invention. *Ex Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990).

9. In this case, claims 77 and 78 recite a system or device as well as steps for its use. Note the recitation " . . .causes a complete generation . . . enabling . . . "

10. Further, claims 77 and 78 recite both structure "a system" and various generators and control units or modules which under the broadest reasonable interpretation of the claims are likely software. Thus it is unclear whether claims 77 and 78 are hardware, software or some combination thereof.

11. For these reasons, independent claims 77 and 78 and their dependent claims 79-84 are rejected under 35 U.S.C. 112, second paragraph.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 77-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dolphin (US 5,457,746) in view of Katz et al (US 5,926,624).

14. Regarding claims 77 and 78 –

15. Dolphin discloses a digital media production system for manufacturing on physical media and on demand at a local site a selected digital information product selected by a customer at the local site after a licensing control center located remotely

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from the local site provides an electronic release code authorizing the on demand manufacturing of the selected digital information product at the local site to the physical media, the system comprising:

a mass data storage device located at the local site and which stores digital information of a plurality of different digital information products including the selected digital information product; (col 22 n 55-56, fig2/31)

a release unit located at the local site and which has a user interface and an output, said release unit: (col 4 ln 55-67)

permits selection of the selected digital information product from among the plurality of different digital information products stored on the mass data storage device by receiving a request via the user interface from the customer to manufacture on demand at the local site the selected digital information product to the physical media, (col 4 ln 55-67) and

issues, via the output, the request as a product release request to the licensing control center; (col 5 ln 7-16)

a media generator located at the local site; col 5 ln 7-16

and

a control unit located at the local site and which controls both the media generator and the package generator, said control unit in response to receiving an electronic release code, which is both unique to and provided only for the selected digital information product by the licensing control center in response to receiving the product release request to authorize the on demand manufacturing of the selected

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digital information product at the local site to the physical media, causes a complete generation by:

enabling the media generator to store on the physical media the digital information of the selected digital information product from the mass data storage device as well as to record on the physical media the issued unique electronic release code for the selected digital information product, (col 5 ln 7-16)

16. Dolphin does not specifically disclose a packaging generator producing physical media packaging for the selected digital information product for packaging the physical media for supply to the customer. However, at col 4 ln 25-38, Dolphin does teach where the publisher, 21, distributes the data on CD—ROM via the US Post Office, or interoffice mail. Therefore, it would be a predictable result in light of Dolphin to provide a mail envelope, box, or similar container for the CD-ROM to be delivered to the user. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

17. Katz discloses, as Dolphin does not, preventing complete generation of any digital information product before receipt of the unique electronic release code issued by the remote licensing control center (col 11 ln 32 – col 12 ln 16, where processing only continues if both systems are authorized systems).

18. It would be obvious to one of ordinary skill in the art at the time the invention was made to combine Dolphin and Katz in order to prevent unauthorized usage of digital media by employing a license on a remote server.

19. Regarding claim 79 –

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20. Dolphin discloses a unique electronic release code includes a license number, and in which the packaging generator is arranged to print at least one of the license number and name of the customer which selected the selected digital information product onto the media packaging. (col 5 ln 40-45, col 5 ln 57-60).

21. Regarding claim 80 –

22. Dolphin does not specifically teach wherein the unique release code includes a license number; and in which there is further included a certificate of authenticity generator arranged to generate a certificate of authenticity including at least one of the license number and the customer's name. However, at, e.g. col 6 ln 11-15, the KMID (key material identifier) of Dolphin is used to show authenticity and positively identify a data set. Note also at, col 7, ln 14-20, col 8 ln 10-15, col 11 ln 24-32, col 11 ln 65-col 12 ln 3, where the “audit” = “certificate” such that the KMID is tied to certain “attributes” (see col 5 ln 10-25) such as a “subscription” or “license”. It would be a predictable result to attach a customer's name to an audit (col 11 ln 25-32). *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)

23. Regarding claim 81 –

24. Dolphin suggests wherein a media generator is arranged to include a user-defined personalization applied to at least one of the surface of the media, and the digital information stored on the media. (Dolphin does not specifically disclose a packaging generator producing physical media packaging for the selected digital information product for packaging the physical media for supply to the customer.

However, at col 4 ln 25-38, Dolphin does teach where the publisher, 21, distributes the

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data on CD—ROM via the US Post Office, or interoffice mail. Therefore, it would be a predictable result to somehow make the CD-ROM suitable for mailing via US mail.

Therefore, it would be a predictable result in light of Dolphin to provide a mail envelope, box, or similar container for the CD-ROM to be delivered to the user. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)., Where the container, would include , *inter alia*, the recipient's address and name, both of which are defined by the user.

Also, e.g. col 6 ln 11-15, it is predictable that the KMID of Dolphin is used to show authenticity and thus would likely include such identifying information as license numbers, names, addresses, etc).

25. Regarding claim 82 –

26. Dolphin discloses wherein a media generator includes a media writer. (e.g. col 4 ln 25-30, how else to store data on a CD-ROM and the send it away by U.S. mail if not by media writer of one sort or another?).

27. Regarding claim 83 –

28. Dolphin discloses wherein the product release code includes a license number, and in which the media generator includes a printer arranged to print onto a surface associated with the selected digital information product at least one of the license number and the customer's name. (e.g. col 6 ln 11-15, it is predictable that the KMID of Dolphin is used to show authenticity and thus would likely include such identifying information as license numbers, names, addresses, etc. Dolphin does not specifically disclose a packaging generator producing physical media packaging for the selected digital information product for packaging the physical media for supply to the customer.

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However, at col 4 ln 25-38, Dolphin does teach where the publisher, 21, distributes the data on CD—ROM via the US Post Office, or interoffice mail. Therefore, it would be a predictable result in light of Dolphin to provide a mail envelope, box, or similar container for the CD-ROM to be delivered to the user. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). Such container would normally include providing some kind of physical mailing envelope labeled with, *inter alia*, the recipient's address and name, both of which are defined by the user. Also, at, e.g. col 6 ln 11-15, the KMID (key material identifier) of Dolphin is used to show authenticity and positively identify a data set. Note also at, col 7, ln 14-20, col 8 ln 10-15, col 11 ln 24-32, col 11 ln 65-col 12 ln 3, where the “audit” = “certificate” such that the KMID is tied to certain “attributes” (see col 5 ln 10-25) such as a “subscription” or “license”. It would be a predictable result to attach a customer's name to an audit (col 11 ln 25-32). *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)

29. Regarding claim 84 –

30. Dolphin discloses wherein the request from the customer also includes details concerning personalized information of the customer received via the user interface, and the product release request further includes data representing the personalized information, and in which the control unit is responsive to the data representing the personalized information by causing the media generator to include the personalized information in the physical media for the selected digital information product. (Also, at, e.g. col 6 ln 11-15, the KMID (key material identifier) of Dolphin is used to show authenticity and positively identify a data set. Note also at, col 7, ln 14-20, col 8 ln 10-

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15, col 11 ln 24-32, col 11 ln 65-col 12 ln 3, where the “audit” = “certificate” such that the KMID is tied to certain “attributes” (see col 5 ln 10-25) such as a “subscription” or “license”. It would be a predictable result to attach a customer’s name to an audit (col 11 ln 25-32). *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)

Conclusion

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CRISTINA SHERR whose telephone number is (571)272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

32. If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Calvin L. Hewitt, II can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

33. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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CRISTINA OWEN SHERR

Examiner

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/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685